

REMARKS

The Office Action dated June 5, 2006, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-66 are currently pending in the application, of which claims 1, 19, 37, 45, 60, and 65-66 are independent claims. Claims 1-66 have been amended to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 1-66 are respectfully submitted for consideration.

Claims 1-2, 4-5, 8-9, 11-13, 16-20, 22-23, 26-27, 29-31, 34-38, 40-41, 44-46, 48-49, 52-53, 55-56, 59-60, and 65-66 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,985,748 of Knotts ("Knotts") in view of U.S. Patent No. 5,610,974 of Lantto ("Lantto"). The Office Action took the position that Knotts teaches all the features of the independent claims except "in which the message comprises roaming information on the user equipment." The Office Action cited Lantto to remedy this deficiency of Knotts. Applicants respectfully traverse this rejection.

Claim 1, upon which claims 2-18 depend, is directed to an apparatus including a first system entity providing a multimedia messaging service to user equipment connected to a network of a system. The apparatus also includes a second system entity providing a value added service to a user of the user equipment via the multimedia messaging service. The first system entity is configured to send a message to the second system entity. The message comprises roaming information about the user equipment.

Claim 19, upon which claims 20-36 and 61-62 depend, is directed to a method including providing a multimedia messaging service in a telecommunications system comprising a first system entity configured to provide multimedia messaging service to a user equipment connected to a network of the system, and a second system entity configured to provide a value added service to a user of the user equipment via the multimedia messaging service. The method also includes sending a message from the first system entity to the second system entity. The message comprises roaming information about the user equipment.

Claim 37, upon which claims 38-44 depend, is directed to a telecommunications system element including providing means for providing multimedia messaging service to user equipment connected to a network. The telecommunications system element also includes sending means for sending a message to a system entity providing a value added service to a user of the user equipment via the multimedia messaging service. The message comprises roaming information about the user equipment.

Claim 45, upon which claims 46-59 and 63-64 depend, is directed to a value added service providing element including providing means for providing a value added service to a user of user equipment connected to a network via a multimedia messaging service that is provided by a multimedia messaging service providing system entity. The value added service providing element also includes receiving means for receiving a message from the multimedia messaging service providing system entity, wherein the message comprises roaming information about the user equipment.

Claim 60 is directed to a computer-readable storage medium comprising a computer program set, wherein the execution of the program set in a computer connected to a telecommunications system causes the computer to execute providing a value added service to a user of user equipment connected to a network of a telecommunications system via a multimedia messaging service that is provided by a multimedia messaging service providing system entity. The execution of the program also causes the computer to execute receiving a message from the multimedia messaging service providing system entity. The message includes roaming information about the user equipment.

Claim 65 is directed to a system including a first system entity means for providing multimedia messaging service to a user equipment connected to a network of the system. The system also includes a second system entity means for providing a value added service to a user of the user equipment via the multimedia messaging service. The system further includes sending means for sending a message from the first system entity means to the second system entity means, wherein the message comprises roaming information about user equipment.

Claim 66 is directed to a method including providing a multimedia messaging service to user equipment connected to a network of a system. The method also includes providing a value added service to a user of the user equipment via the multimedia messaging service. The method further includes sending a message from a first system entity to a second system entity, wherein the message comprises roaming information about the user equipment.

Applicants respectfully submit that the combination of Knotts and Lantto fails to disclose or suggest all of the elements of any of the presently pending claims.

Knotts generally relates to an inter-carrier messaging service providing phone number only experience. As explained at column 5, lines 44-47, Knotts provides subscribing customers phone number only messaging service using native SMS Inter-Carrier Messaging. Knotts, by “phone number only” means that that phone number can be used as the address for the messages, as Knotts explains at column 5, lines 56-59.

Claim 1 recites “a first system entity providing a multimedia messaging service to user equipment connected to a network of a system.” Claim 19 recites “providing a multimedia messaging service in a telecommunications system.” Claim 37 recites “providing means for providing multimedia messaging service to user equipment connected to a network.” Claim 45 “providing means for providing a value added service to a user of user equipment connected to a network via a multimedia messaging service that is provided by a multimedia messaging service providing system entity.” Claim 60 recites “providing a value added service to a user of user equipment connected to a network of a telecommunications system via a multimedia messaging service that is provided by a multimedia messaging service providing system entity.” Claim 65 recites “a first system entity means for providing multimedia messaging service to a user equipment connected to a network of the system.” Claim 66 recites “providing a multimedia messaging serviced to user equipment connected to a network of a system.” Applicants respectfully submit that Knotts fails to disclose or suggest at least these

features of the independent claims, which will be referred to below (merely for convenience) as the multimedia messaging features.

The Office Action took the position that the multimedia messaging features were disclosed by Knotts' abstract. Knotts' abstract, however, indicates that Knotts is directed to a phone number only messaging experience provided by an inter-carrier short message system service. Short message service (SMS), which is the basis for Knotts' application, is not a multimedia messaging service within the nomenclature of one of ordinary skill in the art of messaging. This is because SMS is a different service from multimedia messaging service. SMS allows transmission of short messages between communication devices, as explained by Knotts' at column 1, lines 42-44. However, SMS is not able to transmit multimedia messages but is limited to conventional text content, as explained, for example, by way of contrast in the present application at page 1, paragraph [0002].

Accordingly, it is respectfully submitted that Knotts' disclosure of SMS does not properly correspond to the claimed multimedia messaging features. Moreover, claims 1, 19, 37, 45, 60, 65 and, 66 each recite "wherein the message comprises roaming information about the user equipment." The Office Action admitted that Knotts does not disclose this feature of the independent claims. Accordingly, the Office Action cited Lantto to remedy Knotts' deficiencies. Applicants respectfully submit that Lantto fails to remedy Knotts' deficiencies, and thus the combination of Knotts and Lantto fails to disclose or suggest all of the elements of any of the presently pending claims.

Lantto generally relates to a method and arrangement for handling a mobile telephone subscriber administered in different mobile networks with a common call.

Lantto, at column 1, lines 61-67, explains that it is directed to enabling a subscriber to call a mobile telephone with a same call number regardless of the network in which the mobile telephone is located. Accordingly, Lantto is directed to communication by means of telephone calls, *i.e.* conventional voice-only conversations.

Accordingly, Lantto is naturally silent as to the above-identified deficiencies with respect to the multimedia messaging features of the independent claims. Moreover, Lantto cannot properly be used to provide the recitation “wherein the message comprises roaming information about the user equipment” for which the Office Action cited it, because Lantto cannot properly be combined with Knotts.

The attempted combination of Knotts and Lantto is improper hindsight combination. The Office Action began with the template of the independent claims and tried to reconstruct the invention within that template. To protect against such invalid and inappropriate hindsight reconstruction, the Federal Circuit has ruled that references cannot be selected, and selected elements from selected references cannot be combined, without some suggestion, motivation, or teaching that would render obvious that selection and that combination. *See, e.g., Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001) (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.”); and *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation

to combine the prior art references is an ‘essential component of an obviousness holding’”).

The Office Action has not provided proper motivation to combine the references. The Office Action’s proposed motivation for combining the references is “in order to enable a subscriber to obtain the same type of services in at least two different standard types of network” citing Lantto, at column 2, lines 10-12. However, although Lantto cites such an advantage as an advantage of Lantto as a whole, Lantto does not ascribe that benefit to the feature of “wherein the message comprises roaming information about the user equipment.” Indeed, this feature is described by Lantto at column 15, lines 10-14 (the portion cited by the Office Action) as “well known ... and ... therefore not shown in FIG. 9.” It is not reasonable to, and one of ordinary skill would not, conclude that such a feature is a feature that would accrue the advantages described by Lantto as objects of Lantto’s invention. Accordingly, the alleged motivation is not motivation to incorporate the selected feature of Lantto and introduce into Knotts.

Additionally, Lantto and Knotts are in non-analogous arts, inasmuch as Lantto relates to voice calls and Knotts relates to text messages. Accordingly, one of ordinary skill in the art would also not be motivated to combine the incongruous teachings of Lantto and Knotts, for this additional reason.

It is, therefore respectfully submitted that each of claims 1, 19, 37, 45, 60, and 65-66 recite features that are neither disclosed nor suggested by the combination of Knotts and Lantto and that such a combination is improper. It is, therefore, respectfully requested that the rejection of claims 1, 19, 37, 45, 60, and 65-66 be withdrawn.

Claims 2, 4-5, 8-9, 11-13, 16-18, 20, 22-23, 26-27, 29-31, 34-36, 38, 40-41, 44, 46, 48-49, 52-53, 55-56, and 59 depend from claims 1, 19, 37, and 45 respectively, and recite additional limitations. It is, therefore, respectfully requested that the rejection of claims 2, 4-5, 8-9, 11-13, 16-18, 20, 22-23, 26-27, 29-31, 34-36, 38, 40-41, 44, 46, 48-49, 52-53, 55-56, and 59 be withdrawn.

Claims 6-7, 14-15, 24-25, 32-33, 42-43, 50-51, 57-58, and 61-64 were rejected under 35 U.S.C. 103(a) as being unpatentable over Knotts in view of Lantto and further in view of Official Notice of certain of the features as allegedly “very well known.” With regard to each taking of Official Notice, Applicants respectfully traverse the taking of Official Notice, on the basis that the Official Notice does not address motivation to combine, and thus constitutes impermissible hindsight reconstruction, even if the particular features for which it is applied were well known in some art (not admitted). Evidence is respectfully requested. Applicants respectfully traverse the rejection in general as well.

Claims 6-7, 14-15, 24-25, 32-33, 42-43, 50-51, 57-58, and 61-64 depend from claims 1, 19, 37, and 45 respectively, and recite additional limitations. The deficiencies of the combination of Knotts and Lantto with regard to claims 1, 19, 37, and 45. The taking of Official Notice, even if it were proper, in no way remedies either the multimedia messaging features with regard to which the combination of Knotts and Lantto are silent, nor the feature “wherein the message comprises roaming information about the user equipment” with regard to which Knotts is silent, and Lantto cannot properly be used to remedy the deficiency. It is, therefore, respectfully requested that the

rejection of claims 6-7, 14-15, 24-25, 32-33, 42-43, 50-51, 57-58, and 61-64 be withdrawn.

Claims 3, 10, 21, 28, 39, 47, and 54 were rejected under 35 U.S.C. 103(a) as being unpatentable over Knotts in view of Lantto and further in view of U.S. Patent No. 6,917,813 of Elizondo (“Elizondo”). The Office Action took the position that the combination of Knotts and Lantto teaches most of the features of the claims, but cited Elizondo to teach “the roaming information comprises an address of a switching centre which the user equipment is using” and “the second system entity is configured to determine a location of the user equipment.” Applicants respectfully traverse this rejection.

Claims 3, 10, 21, 28, 39, 47, and 54 depend from claims 1, 19, 37, and 45 respectively, and recite additional features. The deficiencies of the combination of Knotts and Lantto (as well as the impropriety of such a combination) are discussed above. Elizondo does not remedy the above-identified deficiencies of Knotts and Lantto, and thus it is respectfully submitted that the combination of Knotts, Lantto, and Elizondo fails to disclose or suggest all of the elements of any of the presently pending claims.

Elizondo, like Knotts, generally relates to provision of short message services. Accordingly, Elizondo is non-analogous to Lantto in a similar way to which Knotts is nonanalogous to Lantto. Moreover, as explained at column 2, lines 59-65, Elizondo particularly aims to provide SMS services when different Signaling System #7 (SS7) signaling networks are in use, both for SMS termination to mobile units roaming in an SS7 network different than the mobile station’s home network, and for receiving SMS

messages from an SS7 network from the mobile station's network when the mobile station is roaming inside or outside of its home SS7 network.

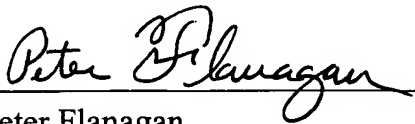
Unsurprisingly, therefore, Elizondo is silent as to the above-identified multimedia messaging features of the claims. It is, therefore, respectfully submitted that Elizondo fails to remedy the deficiencies of Knotts and Lantto, and thus it is respectfully requested that the rejection of claims 3, 10, 21, 28, 39, 47, and 54 be withdrawn.

For the reasons explained above, it is respectfully submitted that each of claims 1-66 recites subject matter that is neither disclosed nor suggested in the cited references. It is, therefore, respectfully requested that all of claims 1-66 be allowed, and that this application be passed to issue.

If, for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in cursive script, reading "Peter Flanagan", written over a horizontal line.

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